

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert B. Nilsen and William P. Rowland
Application No.: 10/731,416 Group: 2872
Filed: December 9, 2003 Examiner: Phan, James
Confirmation No.: 3928
For: OPTICAL STRUCTURES



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REPLY TO ELECTION/RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the Election/Restriction Requirement dated September 26, 2005, the species described with respect to Figure 12 is provisionally elected for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Claims 1-3, 14, 16, 18, 24-29, 41, 42, 44, 45 and 48-50 read on the elected species. Applicants do not hereby abandon or waive any rights in the non-elected species. Upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141.

The Election/Restriction Requirement is being traversed for the reasons set forth in detail below.

The Office Action dated October 26, 2005 contained a requirement under 35 U.S.C. 121 to elect a single disclosed species for prosecution. The Examiner was of the opinion that at least claim 1 is generic.

More specifically, the Examiner was of the opinion that the claims are directed to sixty (60) patentably distinct species.

Applicants have provisionally elected the species disclosed in the embodiment styled "(11) the species depicted in Fig. 12" by the Examiner.

However, we respectfully traverse this election requirement and ask the Examiner to reconsider it.

In particular, we note that the Manual of Patenting Examining Procedure (MPEP), Section 814, requires the Examiner to indicate exactly how the application is to be restricted. Particular limitations in the claims and the reasons why such claim limitations are considered to require restriction to a disclosed species need to be pointed out by the Examiner. It is therefore believed insufficient for the Examiner to simply refer to certain figures in the application without an indication of which claims belong to which supposed claimed species groups. Furthermore, the Examiner must also point out the reasons why such claim species are considered either independent or distinct. A mere statement of conclusion is inadequate.

The Examiner's election requirement is therefore improper and should be withdrawn.

In spite of the foregoing deficiency, we note that the Examiner supposedly has found patentably distinct species of the claimed invention by referring to drawings which are, in fact, illustrations of the very same species. For example, Figs. 10-12 together illustrate an embodiment in which components are dropped onto a substrate. Likewise, Figs. 5-9 relate to an embodiment in which components are spread across a substrate. Figs. 13-14 illustrate an embodiment of placing components on a substrate in a desired location or pattern. Figs. 15-17 relate to an embodiment in which a fill layer covers the components and bonds them to the substrate. Thus, the finding of sixty (60) patentably distinct inventions is improper.

"If the search and examination of all the claims in an application can be made without serious burden, the Examiner must examine them on the merits, even though they include claims to independent or distinct inventions." See MPEP §803. In this case, a serious burden on the Examiner has not been *prima facie* shown. The claims provisionally elected (claims 1-3, 14, 16, 18, 24-29, 41, 42, 44, 45 and 48-50) relate to sheeting with air-backed microstructures. Claims

1-57 all relate to sheeting with air-backed microstructures. Even if claims 1-57 include claims to independent or distinct inventions, the Examiner should be able to search and examine all of claims 1-57 without serious burden.

In view of the foregoing, we respectfully request that the election requirement be withdrawn.

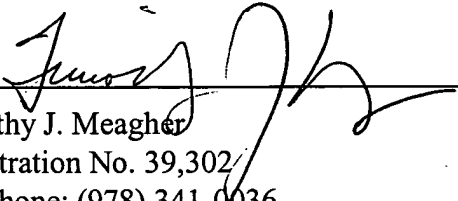
It is noted that a telephone conference to discuss the Restriction/Election Requirement was held on January 13, 2006 with Supervisory Patent Examiner Drew Dunn, David J. Thibodeau, Jr. and the undersigned. While no agreement was reached, Applicants' Attorney appreciates the helpful comments of SPE Dunn.

An extension of time to respond to the Election/Restriction Requirement is respectfully requested. A Petition for an Extension of Time and the appropriate fee are being filed concurrently.

Respectfully submitted,

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